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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,025	07/30/2003	F. Alexander Pettigrew	EI-7583C1(88336)	7777
65297 7590 03/28/2008 FITCH, EVEN, TABIN & FLANNERY P.O. BOX 18415 WASHINGTON, DC 20036				
EXAMINER				
MYHRE, JAMES W				
ART UNIT		PAPER NUMBER		
3688				
MAIL DATE		DELIVERY MODE		
03/28/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/630,025

Applicant(s)

PETTIGREW ET AL.

Examiner

JAMES W. MYHRE

Art Unit

3688

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 March 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Response to Amendment

1. This Office Action is in response to the Amendment filed on March 6, 2008. The amendment submitted new replacement drawings but did not add, cancel, or amend any of the claims. Thus, the currently pending claims considered below remain Claims 1-45.

Drawings

2. The drawings were received on March 6, 2008. These drawings are acceptable.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-45 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-50 of copending Application No. 10/417,465. Although the conflicting claims are not identical, they are not patentably distinct from each other because the two applications are claiming the same steps of awarding emission credits to an entity that adds a second substance to the fuel. The only difference is the identity of the entity which receives the emission credit which does not affect the claimed steps in any way. Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the emission credit could be given to the manufacturer of the fuel, the manufacturer of the fuel-burning vehicle/device, the distributor of either the fuel or the vehicle/device, or even to the end user, if so desired. The same steps for awarding emission credits would be performed in all of these instances.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Applicant is advised that should claim 1 be found allowable, claims 40 and 41 will be objected to under 37 CFR 1.75 as being a substantial duplicates thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing

one claim to object to the other as being a substantial duplicate of the allowed claim.

See MPEP § 706.03(k).

The only difference between independent Claims 1 and 40 is the inclusion of the identity of the intended end-user of the consumable product is, e.g. "a powered mobile platform" (Claim 1); "a powered platform" (claim 40). Since the identity of the intended end-user does not affect the claimed steps of awarding an emission reduction credit to the party providing the consumable product in any way, no patentable weight is given thereto. Thus, the claimed steps are duplicated in both independent claims.

Furthermore, dependent Claim 41 limits the "powered platform" in Claim 40 to "a mobile platform"; thus rendering Claim 41 to be the exact same as Claim 1.

Additionally, dependent claims 36 and 43 each identify the powered mobile platform to be one of the same list of vehicles and will also be objected to as duplicate claims.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-45 are rejected under 35 U.S.C. 102(b) as being anticipated by "VEKTRON 6913 NOx Reduction Strategy Implementation Options" (hereafter VEKTRON). **(Examiner's Note. This document has been dated to November 11, 2001.)**

Claims 1, 30, 31, and 40: VEKTRON discloses a method, comprising:

- a. identifying a first party that provides a product that required a consumable fuel (paragraphs 2, 8, and others);
- b. providing to the first party (from a second party – INFINIUM) a material (VEKTRON 3589) that when combined with the consumable fuel will reduce the emission of a first substance of interest (NOx)(paragraph 8 and others); and
- c. receiving an emission credit for reducing the emissions of the substance of interest (paragraphs 4, 8, and others).

Claims 2-17: VEKTRON discloses a method as in Claim 1 above, and further discloses the consumable product being Shell gas products, which would include all forms of gas products, e.g. gasoline, diesel fuel, etc., and that the substance of interest is nitrogen oxide, sulfur oxide, etc. (paragraph 8 and others). The Examiner further notes that governmental and non-governmental agencies have been awarding emission credits to entities which reduce environmental pollutants, such as greenhouse gases since the early 1990's. The Applicant has identified these agencies as all sizes and types of

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incorporated and unincorporated municipalities, a state, a nation, and multi-national or international bodies such as the United Nations or the European Union (page 2).

Claims 18-20 and 32: VEKTRON discloses a method as in Claims 1 and 31 above, and further discloses identifying a second party and transferring at least some of the emission credit to the second party to offset the second party's emission of a substance of interest (which may be the same or different from the substance of interest for which the first party earned the emission credit) (paragraph 4 and others).

Claims 21 and 22: VEKTRON discloses a method as in Claim 18 above, and further discloses the first party receiving something of value, i.e. money (liquid monetary instrument), from the second party (paragraph 4 and others).

Claims 23-29: VEKTRON discloses a method as in Claims 1 and 22 above, and further discloses that the substance of interest is regulated, either voluntarily or required, by a governmental or non-governmental agency and that the emission credit is awarded directly or indirectly therefrom (paragraph 4 and others). The Examiner notes that little patentable weight is given to the legal requirements for operating the Applicant's or the VEKTRON method of providing emission credits. These legal requirements may change at a moment's notice (even daily) and they may vary greatly between different political entities.

Claims 36 and 41-45: VEKTRON discloses a method as in Claims 1 and 40 above, and further discloses the end-user platform may be mobile or stationary platforms (cars or power generators)(paragraphs 1, 2, and others). Again, the Examiner notes that the type of end-user platform does not affect the method steps of awarding emission credits to the supplier of the consumable product and is given little, if any, patentable weight.

Claims 33-35 and 37-39: VEKTRON discloses a method as in Claim 1 above, and further discloses that the added substance will reduce pollutant emissions by the end-using device (mobile or stationary). While it is not explicitly disclosed how the reduction of the pollutants are achieved by the vehicle/device (e.g. through prudent application of speed, load, miles per gallon, etc.) little if any patentable weight is given to how the reduction is measured. Indeed, the Federal, state, and local incentive programs each have their own measures for qualifying for their emission credits. In any case, the steps of awarding the emission credit in the Applicant's instant invention or in the VEKTRON system would not change whether the reduction was measured by increased mileage, decreased sulfur emissions, increased load carrying ability, or any other measure desired by the awarding agency.

Response to Arguments

8. Applicant's arguments filed March 6, 2008 have been fully considered but they are not persuasive.

a. The Applicant's arguments in reference to the date of the cited reference has been rendered moot by the establishment of the publication date of the reference as November 11, 2001. The below cited additional reference shows that VEKTRON 6913 had been tested and submitted to the government (EPA) for approval prior to March 16, 2001.

b. The Applicant argues in reference to the 102 rejection that "there are major differences between the Vektron reference and the claims in the presently pending application" (pages 11-12). However, since the Applicant did not point out what these differences are, no response can be given.

c. The Applicant argues in reference to the Double Patenting rejection over copending Application 10/417,465 that since "the claims may change during the course of prosecution...the Applicant will file a terminal disclaimer if and when deemed appropriate and when the claims are deemed to otherwise be allowable" (page 12). However, since the claims have not yet been amended, the double patenting rejection still stands as indicated above.

d. The Applicant argues in reference to the duplication claims objection of Claims 1, 40, and 41 that "the claims have differing claim scope" (page 12). However, the Examiner notes that Claim 41 includes the exact same limitations as Claim 1, and Claim 40 includes a trivial difference that does not affect the scope of the method steps being performed. Thus, the objections still stand as indicated above.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Environmental Protection Agency, "Notice of Availability for Public Comments - Infineum Corporation's VEKTRON ® 6913 Gasoline Fuel Additive Test Program", discloses that the VEKTRON additive of the reference used in the rejection had been tested and submitted to the government prior to March 16, 2001.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES W. MYHRE whose telephone number is (571)272-6722. The examiner can normally be reached on Monday through Thursday 6:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JWM
March 25, 2008

/James W Myhre/
Primary Examiner, Art Unit 3688